

REMARKS

Claims 1-29 are pending. Claims 1 and 15 are in independent form. Favorable reconsideration and further examination are respectfully requested.

Applicants thank the Examiner for the courtesy of the telephone conversation with Applicants' representative on April 25, 2006, at which time the language of claim 15 was discussed.

Rejections under 35 U.S.C. § 101

In the action mailed August 11, 2005, claims 1-29 were rejected under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter. In particular, the rejection contends that claims 1-29 "recite functional descriptive material with no practical application" and "fail to produce a useful, concrete, tangible result." The rejection also contends that claims 15-21 are drawn to non-statutory subject matter since they are not limited to embodiments which fall within a statutory category.

Applicants respectfully disagree with all of these contentions on several bases. As for the recitation of "functional descriptive material with no practical application," to begin with, claim 1 is a *method* claim. Applicants respectfully submit that methods are not materials. Thus, claim 1 and its dependencies are not excluded from being patentable subject matter on this basis.

Independent claim 15 does recite a "computer program product, tangibly embodied in an information carrier..." Thus, in contrast with claim 1, claim 15 is directed to a manufacture. However, as pointed out in the rejection, the manufacture recited in claim 15 is *functional*. In particular, the computer program product of claim 15 is functional to cause one or more data

processing apparatus to receive a data variable in a data structure, receive a description of a representation of the data variable information, and change the data variable information from a first representation to the second representation, as recited in claim 15. The computer program product of claim 15 thus clearly imparts functionality when employed as a data processing apparatus component.

According to M.P.E.P. § 2106.IV.B.1,

“When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”

The rejection has not set forth any basis for treating the allegedly functional material recited in claim 15 differently from the way it is to be treated “in most cases,” i.e., as patentable subject matter. Accordingly, since the computer program product of claim 15 is both tangibly embodied in an information carrier and imparts functionality to a data processing apparatus, claim 15 and its dependencies constitute patentable subject matter on this basis.

As for the contention that claims 1-29 “fail to produce a useful, concrete, tangible result,” applicants respectfully disagree. For example, claim 1 recites a method in which information is received and representations of data variable information are mapped. The rejection has set forth no basis for the contention that the receipt and mapping of information is somehow not useful, concrete, or tangible.

Moreover, the contention that the subject matter of claims 1 and 15 is somehow not useful, concrete and tangible flies in the face of the Federal Circuit's holding in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, where the court stated that:

“the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) *cert. denied* 525 US 1093 (1999).

Applicants submit that the mapping of representations of data variable information in claim 1 clearly produces a useful, concrete and tangible result since the mapping of representation of the data variable information is clearly of use in data processing. *See, e.g., Specification*, page 1, line 7-14. As for claim 15, claim 15 recites that the computer program product is operable to cause one or more data processing apparatus to change representations of data variable information—which is clearly a “transformation” of the representations of data.

Accordingly, since both the method of claim 1 and the computer program product of claim 15 produce useful, concrete and tangible results, claims 1-29 constitute patentable subject matter.

As for the contention that claims 15-21 are drawn to non-statutory subject matter since they are not limited to embodiments which fall within a statutory category, applicants respectfully disagree. Claim 15 recites a “computer program product, *tangibly embodied* in an information carrier...” Applicants submit that the *tangible embodiment of a computer program*

product in an information carrier is clearly a manufacture and plainly within the scope of statutory subject matter defined in 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 112

Claims 1-14 and 22-25 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide sufficient written description to satisfy the enablement requirement. In particular, the rejection contends that the specification does not enable one of ordinary skill to map a first representation of the data variable information to a second representation of the data variable information in the absence of input. As discussed further below, claim 1 has been amended to recite that the mapping is to be accomplished in the absence of input from a user regarding how the data variable information is to be mapped.

Applicants submit that support for such a mapping can be found throughout the specification. For example, attention is respectfully directed to FIGS. 9 and 10, tables 1 and 2, and the written description thereof. *Specification*, page 9, line 28- page 13, line 12. In this portion of the text, applicants clearly set forth how to map a first representation of the data variable information to a second representation of the data variable information as claimed.

It is well-established that “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *See, e.g., In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988); M.P.E.P. § 2164.01. Given that applicants clearly set forth how the claimed mapping can be accomplished, applicants submit that, once armed with the disclosure of

the application, one of ordinary skill in the art could have implemented the invention.

Accordingly, applicants submit that claim 1 is enabled by the specification and request that the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Claims 15-21 and 26-29 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide an enabling description. In particular, the rejection contends that the specification enables a computer program product that is operable to cause one or more data processing apparatus to change data variable information from a first representation to a second representation “separately,” but not “independently,” from any change to the data structure.

Although applicants disagree with the basis of the rejection and maintain that the claim language need not appear *in ipso verbis* in the specification to satisfy 35 U.S.C. § 112, claim 15 has been amended to recite that representations of data variable are changed *separately* from any change to the *structure* of the data structure.

Claims 1-14 and 22-25 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly being indefinite for failing to specify exactly what input is absent from claim 1. In response to this rejection, claim 1 has been amended to recite that the first representation is mapped to the second representation in the absence of input from a user regarding how the first and second representations of the data variable information are to be mapped.

Thus, the input that is absent has been clearly and distinctly set forth in a manner that would be understood by one of ordinary skill in the art. Accordingly, applicants request that the rejection of claim 1 be withdrawn.

Claims 15-21 and 26-29 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for reciting the word “independently.” In particular, the rejection contends that the term “independently” is a relative term and that the specification does not provide a standard for ascertaining the requisite degree, presumably, of independence. Although claim 15 has been amended to recite that the change to the data variable information is made *separately* from any change, applicants now address the rejection to advance prosecution.

In particular, Applicants respectfully disagree with the rejection. Applicants are at a loss to understand how the phrases “independently of any change” or “separately of any change” are relative. These phrases do not reference a variable object, nor do the phrases somehow evoke a degree of independence or separateness. The phrases “independently of any change” and “separately of any change” are thus not understood to be relative in the context of claim 15.

Further, even if the phrases “independently of any change” and “separately of any change” were, *arguendo*, terms of degree, relative terms are not necessarily indefinite under 35 U.S.C. § 112, second paragraph. *See, e.g., Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984); M.P.E.P. § 2173.05(b). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed.

The present rejection sets forth no basis for believing that the phrases “independently of any change” and “separately of any change” would not be understood by one of ordinary skill. Instead, the rejection sets forth a bald conclusory statement that one of ordinary skill would not understand the phrase “independently of any change.” This violates 37 C.F.R. § 1.104(2), which requires that the reasons for any adverse action be stated in an Office action.

Since the rejection does not set forth any basis on which the phrase “independently of any change” would not be understood by one of ordinary skill, the rejection of claim 15 is facially deficient and applicants request that it be withdrawn.

Rejections under 35 U.S.C. § 102(e)

Claim 1 was rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication 20020103881 to Granade et al. (hereinafter “Granade”).

As amended, claim 1 relates to a computer-implemented method for managing different representations of information. The method includes receiving information describing a first representation of data variable information in a first data processing system, receiving information describing a second representation of the data variable information in a second data processing system, and mapping the first representation of the data variable information to the second representation of the data variable information in the absence of input from a user regarding how the first and second representations of the data variable information are to be mapped.

Granade is not understood to disclose or to suggest features of claim 1. In this regard, Granade is not understood to disclose or to suggest a computer-implemented method that includes receiving information describing representations of data variable information in data processing systems, much less mapping such representations of data variable information in such a method.

Granade describes an integration system 100 that includes a mobile application server 112 that facilitates mobile devices 106 accessing backend systems 102. *See Granade*, para. [0028]-[0029]. Mobile application server 112 facilitates this access by invoking methods stored and retrieved from an application repository 116. *See Granade*, para. [0029].

Granade's application repository 116 is populated using a mobile tools suite 110. *See Granade*, paras. [0017], [0047]. Mobile tools suite 110 is a collection of tools for use by a human developer to create metadata and methods. *See Granade*, para. [0027]. *See also Granade*, para. [0048] ("A developer uses application builder 402 [of mobile tools suite 110] to create application metadata and other information describing the interaction of an application in an intermediary language."); para. [0050] ("A developer creates methods using interface builder 406 [of mobile tools suite 110]...").

Granade is silent as to details regarding the operation of mobile tools suite 110 and the metadata and methods created there. For example, Granade neither discloses nor suggests that information describing a first representation of data variable information is received by mobile tools suite 110. As another example, Granade neither discloses nor suggests that a first representation of data variable information is mapped to a second representation of data variable information by mobile tools suite 110.

The rejection points to Granade's localization component 210 as allegedly performing the method of claim 1. Applicants respectfully disagree.

In this regard, Granade describes two implementations of localization component 210.

The first implementation acts as a proxy for a mobile device and directs back-end applications to correct their output to correlate to the locale of the mobile device. *See Granade*, para. [0037]. In conveying the locale information for a mobile device to a back-end applications, localization component 210 clearly neither receives information describing representations of data variable information, much less maps such representations, as recited in claim 1.

The second implementation of localization component 210 can translate the language or currency in the output of the back-end application to the language or currency in the desired locale. Granade provides no additional details regarding how the translation is to be performed, and certainly does not describe that information describing representations of data variable information is received, much less that such representations are mapped, as recited in claim 1.

The deficiencies of Granade are further highlighted when one considers the dependent claims also rejected under 35 U.S.C. § 102(e) over Granade. For example, claim 2 recites that mapping the first representation of the data variable information to the second representation of the data variable information comprises establishing machine readable instructions. Localization component 210 clearly does not establish any instructions, but rather only acts as a proxy or translates a language or a currency. Mobile tools suite 110 is understood at least to involve establishing instructions, but Granade is silent as to what those instructions do and how they are established or operate.

As another example, claim 3 specifies that establishing the machine readable instructions includes establishing a criterion for identifying a data variable in a first data structure. Once again, localization component 210 clearly does not establish any instructions, much less establish a criterion for identifying a data variable. Granade is silent as to what any instructions established by mobile tools suite 110 do and operate.

Accordingly, claims 1, 2, and 3 are not anticipated by Granade. Applicants thus request that the rejections of claim 1 and the claims dependent therefrom be withdrawn.

Claim 15 was rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication 20020103881 to Granade et al. (hereinafter "Granade").

Claim 15 relates to a computer program product, tangibly embodied in an information carrier, for managing different representations of information. The computer program product is operable to cause one or more data processing apparatus to receive a data variable in a data structure, wherein data variable information in the data variable has a first representation associated with a first system, receive a description of a second representation of the data variable information, wherein the second representation is associated with a second system, and change the data variable information from the first representation to the second representation separately from any change to the structure of the data structure.

Granade is not understood to disclose or to suggest features of claim 15. In this regard, Granade is not understood to disclose or to suggest a computer program product that is operable to cause one or more data processing apparatus to receive a data variable in a data structure, receive a description of a representation of the data variable information, and change the data variable information from a first representation to a second representation.

As discussed above, Granade describes two implementations of localization component 210. The first implementation acts as a proxy for a mobile device and directs back-end applications to correct their output to correlate to the locale of the mobile device.

In acting as such a proxy, localization component 210 clearly does not need to receive a data variable in a data structure, receive a description of a representation of the data variable information, or change the data variable information from a first representation to a second representation, as recited in claim 15.

The second implementation of localization component 210 can translate the language or currency in the output of the back-end application to the language or currency in the desired locale. Granade provides no additional details regarding how the translation is to be performed. However, once again it is clear that localization component 210 need not receive a data variable in a data structure, receive a description of a representation of the data variable information, or change the data variable information from a first representation to a second representation, as recited in claim 15.

Since Granade is largely silent as to what localization component 210 actually does or how localization component 210 actually operates, Granade fails to anticipate claim 15.

The rejection of claim 15 also asserts that claim 15 incorporates substantially similar subject matter as claim 1. Applicants respectfully submit that the subject matter of claim 15 is determined with reference to the language of claim 15, which clearly differs from the language of claim 1. Applicants therefore request that any basis for rejecting claim 15 be set forth in accordance with 37 C.F.R. § 1.104(2), which requires that the reasons for any adverse action be stated in an Office action. The present rejection is facially deficient on this basis alone.

Accordingly, claim 15 is not anticipated by Granade. Applicants thus request that the rejections of claim 15 and the claims dependent therefrom be withdrawn.

Each of the dependent claims is also believed to define patentable features of the invention. Each dependent claim partakes of the novelty of its corresponding independent claim and, as such, all dependent claims have not been discussed specifically herein.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

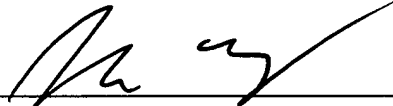
CONCLUSION

Applicants' attorney can be reached at the address shown above. Telephone calls regarding this application should be directed to 858-678-4346.

No fees are believed due at this time. If this belief is in error and fees are due, please charge them to deposit account 06-1050, referencing Attorney Docket No. 13907-058001.

Respectfully submitted,

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